



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,205	11/27/2000	Michael Kalchman	MC010PI	7948

210 7590 11/27/2001

MERCK AND CO INC
P O BOX 2000
RAHWAY, NJ 070650907

EXAMINER

LU, FRANK WEI MIN

ART UNIT	PAPER NUMBER
----------	--------------

1655

DATE MAILED: 11/27/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/701,205

Applicant(s)

KALCHMAN ET AL.

Examiner

Frank W Lu

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1655

DETAILED ACTION

Location of Application

1. The Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1655.

Renumbered Claims

2. Please note that claims 7, 8, 10, and 11 in original application have been canceled. Claim 9 has been renumbered as claim 7 and claims 12-15 have been numbered as claims 8-11 under Patent Rule 1.126.

Election/Restrictions

3. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim 1, drawn to a polypeptide.

Group 2, claims 2 and 3, drawn to a cDNA molecule and a polypeptide.

Group 3, claims 4-6, drawn to a method for reducing the activity of HIP-apoptosis modulating protein.

Art Unit: 1655

Group 4 , claim 7, drawn to an expression vector for expression of a gene in a mammalian host .

Group 5 , claims 8-10, drawn to a method for inducing apoptotic death in cells.

Group 6 , claim 11, drawn to a method for screening a composition for the ability to inhibit apoptosis.

4. The inventions listed as Groups I to VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Groups I and II do not relate to a single general inventive concept because they lack the same or corresponding special technical features. For example, from the claims, there is no correlation between SEQ ID Nos between Groups I and II.

Groups I and III do not relate to a single general inventive concept because they lack the same or corresponding special technical features. For example, the search for SEQ ID No: 5 of Group I is not required for Group III while the search for Huntington's disease of Group III is not required for Group I.

Groups I and IV do not relate to a single general inventive concept because they lack the same or corresponding special technical features. For example, the search for SEQ ID No: 5 of Group I is not required for Group IV while the search for an expression vector of Group IV is not required for Group I.

Groups I and V do not relate to a single general inventive concept because they lack the same or corresponding special technical features. For example, the search for SEQ ID No: 5 of

Art Unit: 1655

Group I is not required for Group V while the search for apoptosis of Group V is not required for Group I.

Groups I and VI do not relate to a single general inventive concept because they lack the same or corresponding special technical features. For example, the search for SEQ ID No: 5 of Group I is not required for Group VI while the search for apoptosis of Group VI is not required for Group I.

Groups II and III do not relate to a single general inventive concept because they lack the same or corresponding special technical features. For example, the search for SEQ ID No: 6 of Group II is not required for Group III while the search for Huntington's disease of Group III is not required for Group II.

Groups II and IV do not relate to a single general inventive concept because they lack the same or corresponding special technical features. For example, the search for SEQ ID No: 6 of Group II is not required for Group IV while the search for an expression vector of Group IV is not required for Group II.

Groups II and V do not relate to a single general inventive concept because they lack the same or corresponding special technical features. For example, the search for SEQ ID No: 6 of Group II is not required for Group V while the search for apoptosis of Group V is not required for Group II.

Groups II and VI do not relate to a single general inventive concept because they lack the same or corresponding special technical features. For example, the search for SEQ ID No: 6 of

Art Unit: 1655

Group II is not required for Group VI while the search for apoptosis of Group VI is not required for Group II.

Groups III and IV do not relate to a single general inventive concept because they lack the same or corresponding special technical features. For example, the search for Huntington's disease of Group III is not required for Group IV while the search for SEQ ID Nos: 2, 4, 5, or 7 of Group IV is not required for Group III.

Groups III and V do not relate to a single general inventive concept because they lack the same or corresponding special technical features. For example, the search for Huntington's disease of Group III is not required for Group V while the search for the death effector domain of a HIP-apoptosis modulating protein of Group V is not required for Group III.

Groups III and VI do not relate to a single general inventive concept because they lack the same or corresponding special technical features. For example, the search for Huntington's disease of Group III is not required for Group VI while the search for the extent of cell death of Group VI is not required for Group III.

Groups IV and V do not relate to a single general inventive concept because they lack the same or corresponding special technical features. For example, the search for SEQ ID Nos: 5 or 7 of Group IV is not required for Group V while the search for the death effector domain of a HIP-apoptosis modulating protein of Group V is not required for Group IV.

Groups IV and VI do not relate to a single general inventive concept because they lack the same or corresponding special technical features. For example, the search for SEQ ID Nos: 5 or 7

Art Unit: 1655

of Group IV is not required for Group VI while the search for the extent of cell death of Group VI is not required for Group IV.

Groups V and VI do not relate to a single general inventive concept because they lack the same or corresponding special technical features. For example, the search for the death effector domain of a HIP-apoptosis modulating protein of Group V is not required for Group VI while the search for the extent of cell death of Group VI is not required for Group V.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Sequence Rules Compliance

5. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Direct the reply to the undersigned.

6. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal

Application/Control Number: 09/701,205

Page 7

Art Unit: 1655


Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The CM Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (703) 305-1270. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

Frank Lu
November 21, 2001



ETHAN C. WHISENANT
PRIMARY EXAMINER